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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/594,457	09/26/2006	Masao Ogawa	129529	9289
25944 7590 11/29/2008 OLIFF & BERRIDGE, PLC P.O. BOX 320850 ALEXANDRIA, VA 22320-4850				
EXAMINER				
DURHAM, NATHANE				
ART UNIT		PAPER NUMBER		
3765				
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11/20/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/594,457

**Applicant(s)**

OGAWA ET AL.

**Examiner**

NATHAN E. DURHAM

**Art Unit**

3765

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 July 2008.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-15 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 and 3-15 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 26 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☒ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

Applicant's amendment and corresponding arguments, filed 30 July 2008, have been reviewed and considered. Claims 1, 3, 7 and 15 have been amended and claim 2 has been canceled. Therefore, claims 1 and 3-15 are currently pending. As discussed in the Interview Summary dated 4 August 2008, the addition of the subject matter of claim 2 (now cancelled) into the independent claims is sufficient in overcoming the prior art rejection(s) as presented in the previous Office Action. However, the applicant's amendment to independent claims 1 and 15 has not fully resolved some of the previous 35 U.S.C. 112, second paragraph issues and the amendment has given rise to further 35 U.S.C. 112, second paragraph issues that will be discussed below. This Office Action is considered a second Non-Final Rejection.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 3-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1, the applicant has amended claim 1 to recite "wherein the sewing machine body or the ink-jet printer is detachably attached to the mounting part

of the frame drive unit separated from the sewing machine body so that the workpiece cloth held on the cloth holding frame moved by the frame drive unit is printed by the printer". This statement is lacking clarity because by stating "the sewing machine body or ink-jet printer is detachably attached to the mounting part of the frame drive unit", the applicant is stating that only one of the sewing machine body and the ink-jet printer is attached to the frame drive unit. This means that a sewing machine body can be attached to the mounting part of the frame drive unit only. If a sewing machine body "is detachably attached to the mounting part of the frame drive unit", how is the sewing machine body "separated from the sewing machine body so that the workpiece cloth held on the cloth holding frame moved by the frame drive unit is printed by the printer"? The sewing machine body cannot be separated from itself. Additionally, a sewing machine body being attached to the drive unit cannot print on the workpiece cloth because the printer performs that function and the printer is not attached when the sewing machine body is attached. The examiner suggests that the applicant define both the sewing machine body and the ink-jet printer to be detachably attachable (instead of detachably attached) to the mounting part of the frame drive unit wherein the sewing machine body and ink-jet printer are separated and discrete from one another (other corresponding minor informalities may also need to be addressed based on the applicant's response). Claims 3-14 are dependent from claim 1 and therefore also rejected under 35 U.S.C. 112, second paragraph.

Claim 15 is rejected under 35 U.S.C. 112, second paragraph for the same reasons as discussed above in the rejection of claim 1 (particularly note the second to

last paragraph of claim 15). Additionally, the applicant's claim language regarding what elements are "detachably attached" to the mounting part of the frame drive unit is unclear. Lines 1-2 of the claim recite that the mounting part of the frame drive unit "is attached to a sewing machine body", lines 5-6 recite that both the sewing machine body and an ink-jet printer are detachably attached to the mounting part, and line 11 recites that either the sewing machine body or the ink-jet printer is detachably attached to the mounting part. The applicant's sewing machine body and the ink-jet printer appear to be discrete machines wherein only one of the sewing machine body and ink-jet printer can be attached to the mounting part of the frame drive unit at a time. What configuration is the applicant claiming? Note the examiner's suggestion of the phrase "detachably attachable" instead of detachably attached" as discussed above. Lastly, the subject matter of lines 8-10 of the claim appear to be repeated within the second to last paragraph of the claim.

#### ***Allowable Subject Matter***

Claims 1 and 3-15 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NATHAN E. DURHAM whose telephone number is

(571)272-8642. The examiner can normally be reached on Monday - Friday, 7:30 am - 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Welch can be reached on (571) 272-4996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NED

/Gary L. Welch/  
Supervisory Patent Examiner, Art Unit 3765